

REMARKS

Upon entry of the present amendment, claims 1-14 will remain pending in the above-identified application and stand ready for further action on the merits.

Claim 1 has been amended and claim 14 has been added. The amendments do not incorporate new matter into the application as originally filed. For example, the amendment to claim 1 simply serves to add clarity when reciting the present invention, without changing the scope of the claim by clarifying that “an absorbent core is arranged between a liquid permeable top sheet and a liquid impermeable back sheet”, and ensuring that proper antecedent basis occurs for all terms used in claim 1.

Regarding newly added claim 14, the same finds support at page 41 of the specification, first full paragraph.

Specification

The title of the specification has been amended herein according to the Examiner's suggestion at page 2 of the outstanding Office Action.

Priority

In the outstanding Office Action, the Examiner indicates that the USPTO has not received a certified copy of all 4 of the Applicant's Japanese priority documents. Applicants respectfully submit that certified copies of each priority document were filed on July 23, 2003. However, a review of the USPTO PAIR Database indicates that a certified copy of JP 2002-213763 has not been scanned into the electronic file wrapper for this application. As such, a

certified copy of the JP 2002-213763 priority document is being submitted concurrently herewith. As such, it is submitted that copies of all Japanese priority documents have now been filed with the USPTO.

Claim Objections

Claim 1 has been objected to for containing certain informalities. Claim 1 is amended herein so that the informalities noted in the outstanding office action have been removed and/or overcome. As such, withdraw of the objection to claim 1 is required at present.

Claim Rejections under 35 USC § 103(a)

Claims 1-13 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Hayase et al. (US 2002/0049421 A1). Claims 1-2, 6-7 and 9-11 have also been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Sasaki et al. (US 2003/0078556 A1). Reconsideration and withdrawal of each of these separate rejections is respectfully requested based upon the following remarks and considerations.

Legal Standard for Determining Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit

showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Present Invention and Its Advantages

The present invention relates to a disposable diaper, which makes it easy to ensure absorption sufficient for absorbing a large amount of body waste, and has improved performance of preventing leakage from the crotch portion.

More particularly, the present invention relates to a disposable diaper having a liquid-holding type absorbent article body in which an absorbent article is arranged between a liquid permeable top sheet and a liquid impermeable back sheet, in which a pair of right and left leg openings through which the legs pass at least at the time of wearing the disposable diaper is formed, and a plurality of leg portion elastic members is arranged around the respective leg openings in an extended state, wherein the leg portion elastic member includes at least one first leg portion elastic member provided in the front side portion applied to the abdomen of a wearer so as to draw an arc along the leg openings, and at least one second leg portion elastic member provided in the back side portion applied to the back of the wearer so as to draw an arc along the leg openings, and isolated from the first leg portion elastic members in the crotch portion applied

to the crotch of the wearer when worn, the minimum width of the absorbent article body at the crotch portion is within the range of from about 250 to 350 mm, and the opposite side edges in the width direction of the absorbent article body in the crotch portion bend towards the external surface when worn, so that the respective side edges in the width direction serve as leg flap absorbent articles which abut against the inner part of the thigh of the wearer.

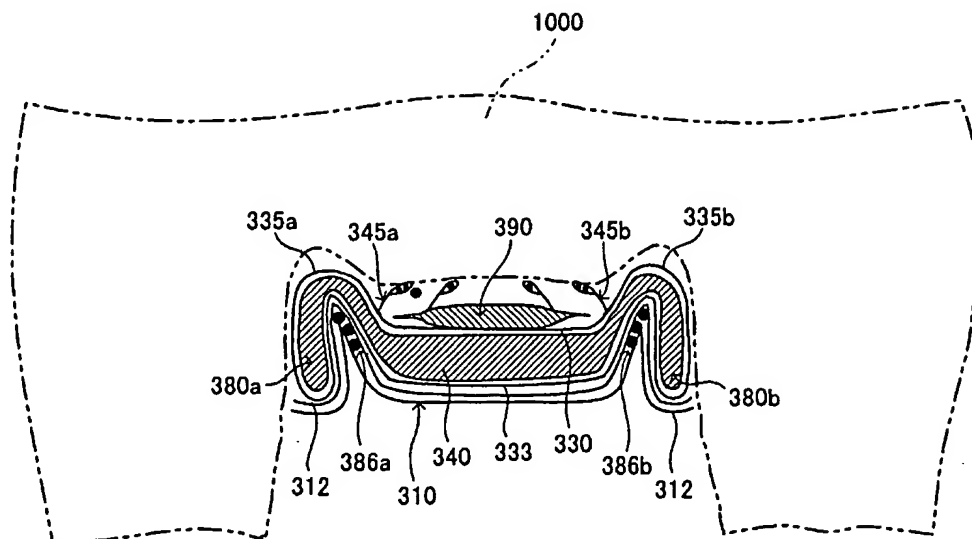
Distinctions Over the Cited Art of Record

The Examiner regards opposite side edges in the width direction of absorbent article body in the crotch portion disclosed in Hayase et al. and Sasaki et al. as the leg flap absorbent of the present invention. However, these are not the leg flap absorbent of the present invention in terms of structure and function.

In instant claim 1, opposite side edges in the width direction of the absorbent article body in the crotch portion need to bend towards an external surface when worn so that the respective opposite side edges in the width direction form leg flap absorbent articles.

That is to say, “opposite side edges in the width direction of absorbent article body in the crotch portion” have to bend downward to be “leg flap absorbent articles” (see Fig. 13 of the instant specification, which is reproduced below for the Examiner’s convenience).

Fig. 13



By the way, “opposite side edges in the width direction of absorbent article body in the crotch portion” correspond to “the free end of the cuffs 8” in Hayase et al. and “the free inner and outer side regions 22a, 22b of the side flaps 22” in Sasaki et al.

As for the structure and the function of opposite side edges, Hayase et al. describes that “the cuffs 8 stand upright to present barriers against the flow of liquid waste flowing in the lateral direction” (see paragraph [0017], lines 8-9 of Hayase et al.).

Similarly, Sasaki et al. describes that “contraction of the elastic members 23 causes the free inner and outer side regions 22a, 22b of the side flaps 22 extending between each pair of the adjacent cross regions 24 to rise on the topsheet 19. The side flaps 22 of inner pad 18 extending between each pair of the adjacent cross regions 24 are tightly placed around the wearer’s thighs and thereby form barriers against bodily discharges” (see paragraph [0037], lines 3-9 and Figure 1).

In both Hayase et al. and Sasaki et al., opposite side edges of the absorbent article body stand upward to be a barrier.

Because opposite side edges of absorbent article body disclosed in Hayase et al. and Sasaki et al. do not bend downward but stand upward, they cannot be leg flap absorbent articles.

Accordingly, because the leg flap absorbent articles of the present invention are not disclosed in Hayase et al. and/or Sasaki et al. it follows that instantly amended claim 1 is non-obvious over Hayase et al. and Sasaki et al. In this regard, neither of the cited art references provide any teaching or motivation to those of ordinary skill in the art that would allow them to arrive at the instant invention as claimed.

As mentioned above, the Applicants believe that claim 1 as currently amended is now allowable. Therefore, it also follows that claims 2-14, which all ultimately depend from claim 1 are also allowable. However, for completeness the following comments are also presented with regard to dependent claims 2, 5-7 and 12.

Claim 2 -

As defined in claim 1, opposite side edges of an absorbent article body need to have an absorbent core to be leg flap absorbent articles.

However, in Sasaki et al., opposite side edges of the inner pad, which is side flap 22, do not have an absorbent core 21 (see, Figure 4). Therefore, the inner pad in Sasaki et al. is not an absorbent article body.

Claim 5 -

As described above, leg flap absorbent articles are not disclosed in Hayase et al. Accordingly, it also follows that the length of leg flap absorbent articles is not disclosed in Hayase et al.

Claims 6 & 7 -

As described above, leg flap absorbent articles are not disclosed in Hayase et al. Accordingly, neither leg flap elastic members nor leg flap side elastic members are disclosed in Hayase et al. As for claim 7, there is no description of the extending stress in Sasaki et al.

Claim 12 -

As described in paragraph [0040] of Sasaki et al., 19b means transversely opposite side regions of the top sheets 19. Therefore, it is submitted that 19b does not mean emboss.

CONCLUSION

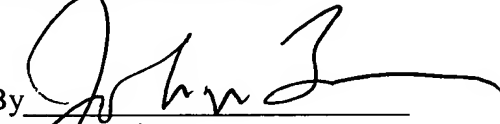
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-14 is allowed and patentable under the provisions of Title 35 of the United States Code.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

By 

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